

## REMARKS

This is a full and timely response to the non-final Office action mailed January 2, 2008. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **Present Status of Patent Application**

Upon entry of the amendments in this response, claims 1-20 are pending in the present application. More specifically, claims 1 and 2 have been currently amended without introduction of new matter and claims 3-20 are new claims that are being submitted without introduction of new matter.

Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### **Summary of Examiner Interview**

Applicants thank Examiner for the telephone conversation he had with Applicants' representative on March 25, 2008. The telephone call was initiated by Applicants' representative in order to clarify certain material on page 2 of the current Office action. Specifically, the clarification was directed at the rejection of claim 2, which is a method claim in contrast to apparatus claim 1. The Office action fails to acknowledge one of the claim elements of claim 2. Therefore, Applicants' representative requested that any future Office action address each claim individually so as to permit a suitable and specific response to each claim. Examiner was amenable to the request and offered to keep it in mind. However, no specific agreements were reached in terms of the pending claims or any other matters.

### **Claim Rejections under 35 U.S.C. §103**

#### **Statement of the Rejection**

*Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (US 6,139,362) in view of Vatterott et al. (US 2002/0100363 A1).*

## Response to the Rejection

### Claim 1

Applicants respectfully traverse the rejection of claim 1 because the Office action fails to satisfy the requirements for a proper rejection of this claim under 35 U.S.C. 103(a).

Specifically, the rejection uses two disparate pieces of art and selectively combines certain elements from the two to allege that claim 1 would be obvious. In this matter, it may be relevant to draw attention to KSR International Co. v. Teleflex Inc., No. 04-1350 (April 30, 2007), wherein the Court stated that "*a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.*" *Id.* at 14.

The KSR court further stated that "*it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does . . . because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.*" *Id.* at 14-15.

Turning now to the MPEP, attention is drawn to MPEP § 2141. III Rationales To Support Rejections Under 35 U.S.C. 103, which states in pertinent part:

"Office personnel must explain why the differences(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. . . . The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR, 550 U.S. at \_\_\_, 82 USPQ2d at 1396."

(Emphasis added)

Applicants respectfully assert that the Office action fails to provide articulated reasoning for combining Brown with Vatterott and furthermore, improperly justifies making such a combination by using an unsubstantiated and conclusory statement. Specifically, the Office action admits that the cited prior art of Brown fails to disclose a "recess" as cited in

Applicants' claim 1. However, the Office action then goes on to allege that "*it would have been obvious to one having ordinary skill in the art at the time invention was made to employ a recess located about a hole on the second side since one would be motivated to secure the fixing portion within the hole. The recess enables the fixing portion to be surrounded by the hole thereby improving the security of the device*" (emphasis added). Applicants respectfully assert that such an allegation is merely conclusory and is unsubstantiated in light of the reasons provided by Applicants for using a recess (surface mounting) as well as the fact that the cited prior art individually and combinedly fails to provide any rationale for "improving the security of the device."

It may be further relevant to point out that a rejection must, by law, be carried out without using legally impermissible hindsight gained from Applicants' own disclosure. In this matter, attention is drawn to MPEP 2141.01 (III. Content of the Prior Art is Determined at the Time the Invention was made to avoid Hindsight), which recites in part: "*It is difficult but necessary that the decision maker forget what he or she has been taught...about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the \*\*art. >...<*" W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)."

Referring back to a portion of the Office action statement reproduced above, Applicants agree that "*to secure the fixing portion within the hole*" is a legitimate assertion, because Brown does indeed disclose a fastener (2) that is inserted into a board opening (33) such that arms (6a and 6b) act as springs "*for engaging the side walls of openings formed in the PCB thereby providing a retention force*" (Brown col. 2, lines 52-53) (emphasis added).

However, Applicants respectfully assert that such a feature does not substantiate the Office action allegation that a person of ordinary skill in the art would be motivated to include a recess in Brown's hole. The grabbing action of Brown's springs is directed towards the side walls of the hole, thereby making the incorporation of an additional recess completely irrelevant, specially in light of the fact that Brown does not provide any reason to do so.

Referring back to another portion of the Office action statement reproduced above, Applicants are inclined to presume that the use of the phrase "*improving the security of the device*" in the Office action may be a typographical oversight and the intended phrase may be

in fact be “*improving securing of the device*” which is directed to a “securing” aspect rather than a “security” aspect. Assuming that such a conclusion is accurate, Applicants respectfully submit that the rationale for this statement is baseless (vis-à-vis Applicants’ “recess”) because Brown uses the sidewalls of his hole for securing his fastener and the need to incorporate an additional recess (for improving securing) is not reasonably explained in the Office action.

Brown also discloses that his “*fastener 2 may or may not protrude through the hole openings 33*” (col. 4, lines 35-36) (emphasis added). One of ordinary skill in the art would reasonably conclude from such an assertion that Brown does not attach any particular significance to the length of his fastener, and certainly does not indicate that it would be desirable to limit the length such that the fastener does not protrude beyond the board. In light of this, one of ordinary skill in the art would not be motivated to explore the use of a recess or other means to prevent a protrusion. In contrast, Applicants have clearly disclosed in their original specification that this lack of protrusion is highly desirable for accommodating surface mount applications.

Applicants respectfully draw further attention to the MPEP for an additional aspect associated with a rejection under 35 U.S.C. 103(a). Specifically, attention is drawn to MPEP 706.02(j), which requires that the Examiner should explain how to combine references, in this case Vatterott with Brown.

“35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate, (B) the difference or differences in the claim over the applied reference(s), (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (D) an explanation >as to< why >the< claimed invention would have been obvious to< one of ordinary skill in the art at the time the invention was made\*\*.” (Emphasis added)

The Office action states that “*Vatterott et al. discloses a recess located about a hole on the second side (Fig. 1, ref. 135, 126.)*” The numeric designators cited in this statement (i.e. 135 and 126) pertain to a screw 135 mounted in a retainer 126. Examiner fails to explain how Vatterott’s screw has any meaningful relationship to Brown’s fastener which uses arms that

act as springs for grabbing. Brown specifically points to the advantages provided in his fastener whereby “*the arms tend to splay outwards when a withdrawal force is applied to the fastener causing the arms to bite into the side walls of the opening.*” Such an action is not provided by a screw which typically does not provide an appropriate resistance as desired by Brown, when withdrawn from a hole.

Consequently, Applicants respectfully submit that the combination of Vatterott and Brown fails to provide a reasonable expectation of success. Therefore, it would be illogical and unreasonable to selectively pick certain elements (recess, hole, length of screw, etc. etc) from such incompatible references solely for the purposes of carrying out a rejection under 35 U.S.C. 103(a).

In addition to failing to provide a reasonable expectation of success when combining Vatterott with Brown, Applicants further assert that Brown in fact “teaches away” from the use of a screw such as disclosed in Vatterott. In this matter attention is drawn to Brown’s col. 1, lines 48-55, which disclose the disadvantage in conventional fasteners, including a screw (Brown col. 1, line 43), thereby leading one of ordinary skill in the art to believe that it would be counterproductive to combine aspects of Vatterott’s screw with that of Brown’s fastener.

In summary, for at least the reasons disclosed above, Applicants respectfully assert that the rejection is improper and hereby request withdrawal of the same. Nonetheless, in the interests of moving forward prosecution in the case and providing focus upon certain aspects that are not reasonably taught or disclosed in the cited prior art, Applicants have opted to currently amend claim 1. Consequently, in light of the amendment and other reasons stated above, Applicants respectfully request withdrawal of the rejection followed by allowance of claim 1.

### Claim 2

Claim 2 is a method claim in contrast to claim 1, which is an apparatus claim. Consequently, the scope of these two claims is distinct and different from one another. However, the Office action fails to acknowledge this distinction because it combines the rejection of claim 2 with that of claim 1 by providing a common rationale for the rejection. In doing so, the Office action fails to disclose why at least that portion of claim 2 that cites “*reforming the heat stakes into the recesses in the substrate*” is unpatentable over Brown in view of Vatterott.

Notwithstanding this shortcoming, Applicants have opted to currently amend claim 2. The amendment is being carried out solely for purposes of clarifying the scope of the claim and moving forward prosecution in the case. As amended, the claim now includes a thermoplastic heat stake having a shaped tip that is melted thereby confining the material inside the recess in the substrate. This aspect is not reasonably taught or disclosed in the cited prior art. Consequently, for at least this reason, Applicants respectfully assert that claim 2 is allowable and hereby request withdrawal of the rejection followed by allowance of the claim.

**Remarks related to new claims**

Applicants respectfully submit that new claims 3-20 are allowable over the cited prior art and hereby request consideration and allowance of the claims.

**Prior Art Made of Record**

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

## **CONCLUSION**

In light of the reasons set forth above, Applicants respectfully submit that pending claims 1-20 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned representative at (404) 610-5689.

Respectfully submitted,

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I hereby certify that this paper is being electronically transmitted to the Commissioner for Patents on the date shown below:

Date of transmission: 25 March 2008

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